PATENT
Attorney Docket No. 03806.0537

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Isabella ARNOULD-REGUIGNE *et al.*

Appln. No.: 10/072,900

Filed: February 12, 2002

For: NUCLEIC ACIDS OF THE HUMAN ABCA12 GENE, VECTORS CONTAINING SUCH NUCLEIC ACIDS AND USES THEROF

Group Art Unit: 1634

Examiner: Juliet Caroline Switzer

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In reply to the restriction requirement dated May 16, 2003, Applicants submit this response. In view of the concurrently filed Petition for a One-Month Extension of Time and fee, this response is due July 16, 2003, and is timely filed.

The Examiner required restriction under 35 U.S.C. § 121 between:

Group I: claims 1-9, 12-13, 16-25, 31-32, and 40, drawn to nucleic acids, vectors, host cells, kits, and pharmaceutical compositions comprising the same, classified in class 536, subclass 23.1 and/or class 424/93.1.

Group II: claims 10-11 and 14-15, drawn to nucleic acid detection methods, classified in class 435, subclass 6 or 91.2.

Group III: claims 26 and 34-35, drawn to polypeptides, classified in class

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530, subclass 350.

Group IV: claims 27-28 and 30, drawn to antibodies, classified in class 530, subclass 387.1.

Group V: claim 29, drawn to methods of detecting polypeptides, classified in class 435, subclass 7.1.

Group VI: claim 33, drawn to method for manufacturing a medicament, classified in class 514, subclass 44.

Group VII: claims 36-39, drawn to methods of screening for active ingredients, classified in class 436, subclass 501. Office Action, page 2.

The Office also requires further restriction to "either **(a)** SEQ ID NO: 1 and 3 which encode SEQ ID NO. [5], or **(b)** SEQ ID NO: 2 and 4 which encode SEQ ID NO. 6." *Id.*

Applicants elect, with traverse, **Group I**, claims 1-9, 12-13, 16-25, 31-32, and 40, drawn to nucleic acids, vectors, host cells, kits, and pharmaceutical compositions comprising the same, classified in class 536, subclass 23.1 and/or class 424/93.1; **and (a)** further drawn to either SEQ ID NO: 1 and SEQ ID NO: 3, which encode SEQ ID NO: 5.

The Office contends that the inventions of Groups "I and II and inventions I and VI are related as product and process of use." *Id.*, page 3. The Office's position is that restriction is proper because "inventions I-VII require different searches that are not coextensive." *Id.* Applicants disagree.

Applicants traverse the restriction requirement on at least the grounds that the Office has not shown there would be a serious burden to examine the full scope of the

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claims of Groups I, II, and VI together. This serious burden is one necessary criterion for a restriction requirement. M.P.E.P. § 803. Applicants respectfully submit that a search of the subject matter of Group II, in addition to the subject matter of Groups I and VI, would not be unduly burdensome because a search of the subject matter of Group II should encompass the search of the subject matter of Groups I and VI since the claims recite the same SEQ ID Nos. Further, this burden is lowered even more because the Office has required Applicants to elect the SEQ ID Nos. in "(a)" or "(b)." Accordingly, Applicants respectfully request that the Office examine at least claims 1-25, 31-33, and 40 together in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 16, 2003

By: _____
Charles D. Niebylski
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